

REMARKS

Applicant has carefully reviewed the Official Action dated April 29, 2008, for the above identified patent application.

Applicant has amended the form of pending Claims 1 - 20 to more closely conform to the current Rules of Practice, and to emphasize the nature of the claimed invention.

For the reasons to be discussed below, Applicant respectfully submits that all pending claims are allowable over the prior art applied in the Official Action.

At page 2 of the Official Action, Claims 1 - 3, 10 - 12, and 17, have been rejected under 35 U.S.C Section 102(b) as being anticipated by Schmanski et al (U.S. Pat. 5,189,822).

At page 4 of the Official Action, Claims 8 - 9 and 18 have been rejected under U.S.C. Section 103(a) as being obvious over Schmanski et al.

At page 5 of the Official Action, Claims 13 - 16 and 19 - 20 have been rejected under 35 U.S.C. Section 103(a) as being obvious over a combination of Schmanski et al in view of published U.S. Patent Appl. US 2007/0101629 (Deniz).

Independent Claim 1 is directed to a sign including "at least one undercut groove (6)". The undercut groove (6), as disclosed and claimed by Applicant, refers to material cut away from the main body (1) of the sign, leaving an overhanging portion in relief.

The Official Action contends that the trough (22) disclosed by Schmanski et al is equivalent to the undercut groove (6), as disclosed and claimed by Applicant. On the contrary, the trough (22) disclosed by Schmanski et al is a recess with slanted sides and does not include an overhanging portion, and thus is not an undercut groove, as disclosed by Applicant and recited in independent Claim 1.

Independent Claim 1 also expressly recites that the undercut groove (6) accommodates at least one clamping slide (15). At page 3 of the Official Action, the Examiner contends that the end cap (32) illustrated in Fig. 1 of Schmanski et al, and discussed at Col. 4, line 18 of the Schmanski et al specification, is a clamping slide accommodated within the undercut groove 22. Assuming arguendo that the trough (22) of Schmanski et al is an undercut groove (a proposition with which Applicant disagrees), neither Fig. 1 nor the specification of Schmanski et al discloses that the end cap (32, 34) is accommodated within the trough (22). On the contrary, Fig. 2 of the drawings of Schmanski et al illustrates that the end caps are arranged completely outside the trough (22).

Therefore, Schmanski et al fails to teach, disclose or suggest two positively recited features of the sign defined by independent Claim 1. Schmanski et al does not teach the undercut groove (6) as disclosed and claimed by Applicant, and does not teach the arrangement in which the undercut groove accommodates at least one clamping slide, as disclosed and claimed by Applicant.

Independent Claim 1 was rejected as being anticipated by Schmanski et al. It is well established that a rejection of a claim as being anticipated by a prior art reference requires the Patent & Trademark Office to establish a strict identity of invention between the rejected claim and the single applied prior art reference. Stated in other words, a rejection of a claim as being anticipated by a prior art reference is improper unless the prior art reference discloses all features of the claim, as arranged in the claim. See, for example, Connell v. Sears, Roebuck & Co., 220 USPQ 193 (Fed. Cir. 1983).

In the instant case, as discussed above, Schmanski et al does not teach (or suggest) positively recited structure in independent Claim 1 (the undercut groove (6)), and does not teach (or suggest) positively recited arrangement in independent Claim 1 (that the undercut groove (6) accommodates at least one clamping slide (15)).

Applicant respectfully submits that Schmanski et al does not anticipate (or suggest) the sign defined by independent Claim 1, when all positively recited features of this claim are considered. Accordingly, independent Claim 1 is in condition for allowance. The remaining dependent claims, which depend directly or indirectly from independent Claim 1 and include all features of that claim, are also allowable, at least for the same reasons as parent independent Claim 1.

In addition to the above, Applicant respectfully submits that dependent Claims 13 - 16 and 19 - 20, which were rejected over a combination of Schmanski et al in view of the published U.S. patent application to Deniz, are allowable because the Deniz publication is not prior art to the present patent application. The present United States patent application, which is the U.S. National Phase of PCT/EP2005/001101, is entitled to an effective United States filing date of February 1, 2005, which corresponds to the PCT filing date. The Deniz patent application was filed on November 7, 2005, and was published on May 10, 2007. Accordingly, the effective United States filing date for the present application precedes both the filing date of the Deniz patent application, and the publication date of the Deniz patent application. Therefore, the published Deniz patent application is not statutory prior art to the present application under 35 U.S.C. Section 102(b) or 102(e).

Since the published Deniz patent application is not statutory prior art to the present patent application, a combination of Schmanski et al and the Deniz publication is an improper rejection, as a matter of law, since one of the combined references is not statutory prior art. Accordingly, Claims 13 - 16 and 19 - 20, which have been rejected over a combination of Schmanski et al and the Deniz publication, are allowable over the prior art applied to reject them.

Applicant respectfully submits that all pending claims are in condition for allowance, and favorable action is respectfully requested.

Respectfully submitted,



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